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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,616	01/11/2001	Edith Helen Stern	YOR920000604US1	2797
35526	7590	11/30/2005	EXAMINER	
DUKE. W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			HAVAN, THU THAO	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,616

Applicant(s)

STERN ET AL.

Examiner

Thu Thao Havan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 34-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 34-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Response to Amendment

Claims 1-25 and 34-47 are pending. This action is in response to the amendment received September 13, 2005.

Response to Arguments

Applicant's arguments with respect to claims 1-25 and 34-47 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-25 and 34-47** are rejected under 35 U.S.C. 102(e) as being anticipated by Stanley et al. (US application no. 2002/0111888).

Re claims **1, 14, and 34**, Stanley teaches preparing a tax return (abstract) comprising the steps of: authorizing a financial recording service provider to receive tax data resulting from transactions between a client taxpayer and one or more specified financial institutions

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(para. 0013-0014 and 0053), wherein each of said transactions occurs during a subsequent time period beginning after said authorization (para. 0015, 0017, 0030, and 0063); transmitting said tax data resulting from transactions between said taxpayer and a given one of said financial institutions directly from said given institution to said financial recording service provider (para. 0030); storing all of said transmitted tax data under the control of said financial recording services provider (para. 0031 and 0042); and sending all of tax data from said financial recording service provider to a tax return preparer, for use in preparing a tax return for said taxpayer, after the end of said time period (para. 0040 and 0071). *In other words, Stanley discloses automated tax return preparation. The taxpayer is interviewed and his information is collected from financial institutions. In that the tax software retrieves tax data directly from the financial institutions. His system retrieves tax data by a universal data import (UDI). UDI enables a just-in-time style import whereby data can be imported throughout by connecting to financial institutions on an as-needed basis to obtain the data. In that, tax information is obtained over the course of the tax year. Overall, Stanley's application enables an automated tax return system to prepare tax returns in advance with minimal user assistance.*

Re claim 2, Stanley teaches no tax data other than said tax resulting from said transactions that occur during said time period is transmitted from said specified financial institutions to said financial recording service provider, in regard to said client taxpayer (para. 0079 and 0130). *In other words, Stanley teaches only the most up to date and most relevant tax information is be transmitted during a particular time period.*

Re claim 3, Stanley teaches time period comprises a specified fiscal year, and tax data pertaining to a particular transaction is transmitted to said financial recording service provider at the time said particular transaction occurs (para. 0016). *Stanley inquires about tax data based on the specific year.*

Re claim 4, Stanley teaches tax return preparer is a separate and distinct entity from said financial recording service provider (para. 0050).

Re claims 5, 8, 18, 21, 38, and 42-43, Stanley teaches updating the client taxpayer's tax data with additional financial data (para. 0044 and 0129). *In other words, Stanley updates as needed of the information in relation to the taxpayers.*

Re claims 6, 19, and 39, Stanley teaches preparing a tax return (abstract) comprising the steps of: receiving tax data associated with a client taxpayer from a financial institution during a specified fiscal year (para. 0030 and 0016); inserting the tax received from the institution into a tax return during the specified fiscal year (para. 0009); validating the tax data in the tax return (para. 0017); and submitting the tax return to a tax authority after the end of the specified fiscal year (fig. 13).

Re claims 7, 20, and 41, Stanley teaches client taxpayer may validate the tax data in the tax return (para. 0014-0015).

Re claims 9-10, 15, 22-23, 35, and 40, Stanley teaches validated tax data is submitted to a tax authority (para. 0053). *In other words, Stanley validates tax data by using an EIN as a primary check for an authorized financial institution.*

Re claims 11, 17, 25, and 37, Stanley teaches validated tax data is submitted to a tax return preparation service (para. 0030, 0131, and 0132).

Re claims **12** and **46**, Stanley teaches validating the additional tax data is performed by the institution (para. 00131-132).

Re claims **13** and **47**, Stanley teaches billing the client taxpayer subscriber (para. 0034). *In other words, Stanley discloses preparing the taxpayer information for a fee, which corresponds to billing the taxpayer.*

Re claims **16, 24, 36**, and **44-45**, Stanley teaches validated tax data is submitted to the financial recording service provider (para. 0014).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH
11/18/2005



HANI M. KAZIMI
PRIMARY EXAMINER